

REMARKS

This paper is responsive to the Advisory Action mailed October 23, 2006. This document incorporates by reference all of the previously made remarks and amendments of the Response to the final Office Action filed on September 26, 2006. The Examiner refused to consider new claims 70–91 and stated that claims 50 and 62 require further consideration. A Request for Continued Examination (RCE) is filed concurrently with this Amendment and Response and addresses the remaining issue in this application.

Applicant by way of amendment has overcome the rejection under 35 USC § 101 for claim 50, the rejection under 35 USC § 112 ¶1 for claims 11, 13–15, and the rejection under 35 USC § 112 ¶2 for claims 11, 13–15, and 50.

I. Summary of the Examiner's Rejection

Claims 5, 11, 13–15, 18–22, 50–58, and 60–69 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over International Patent Publication No. WO 97/37328 to Ouimet et al. in view of International Patent Publication No. WO 98/04080 to Zeitman.

The Examiner believes a smart card, as disclosed in Ouimet, may inherently include a microprocessor and a wireless communication means.¹ The Examiner argues that since the Applicant's specification does not limit the scope of the claimed reference identifier, the claims can read on the invention as disclosed in Ouimet in light of Zeitman.²

¹ July 27, 2006, Final Office Action, paragraph 8.

² October 23, 2006, Advisory Action, Continuation Sheet Item No. 11.

II. Applicant's Response to Examiner's Rejection

Applicant claims a priority date of May 9, 2000. Ouimet and Zeitman claim as a priority date 1996.³ To establish a claim of obviousness, the Examiner must set forth in the Office Action “(D) an explanation why one of ordinary skill in the art at the time the invention was made would have been motivated to make the proposed modification.” MPEP § 706.02(j). “The obviousness standard, while easy to expound, is sometimes difficult to apply. It requires the decisionmaker to return to the time the invention was made.” *Uniroyal, Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044 (Fed. Cir. 1988). While Ouimet and Zeitman were available as prior art, these references, when referring to a Smart Card, must be read based on the state of the art as of May 9, 2000, not the state of the art as of 2006. The same standard applies for features found to be inherent under a obviousness standard. *In re Newell*, 891 F.2d 899 (Fed. Cir. 1989). Hindsight is a trap. *In re Dembiczak*, 175 F.3d 994 (Fed. Cir. 1999).

The Examiner construed the term “smart card” found in Ouimet with the advantage of hindsight. The proper question should be “What was a Smart Card back in May of 2000?” The Examiner has taken “official notice” of the fact that the smart card, shown as element 53 in FIG. 5 of Ouimet (see below), may be read as Applicant’s “reference identifier.” The Examiner believes smart cards

³ Ouimet claims priority from April 2, 1996, and Zeitman claims priority from July 21, 1996.

inherently disclose a wireless communication means and a processor.⁴ The Examiner is wrong, because in 2000, smart cards did not disclose inherently wireless communication means. Even today this is not the case.

In 2006, smart card-equipped integrated circuits are available in either the original technology with electrical connectors (contact smart card), known as metal plates located around a small gold color chip of about one-half inch in diameter on the front of the card, or technology with an imbedded RF antenna wire in the card (contactless smart cards a/k/a Wireless Smart Cards).⁵ FIG. 5 of Ouimet clearly shows a contact smart card, not a contactless smart card. Contact smart cards require a reader, and the terminal 18 shown in Ouimet includes a reader.

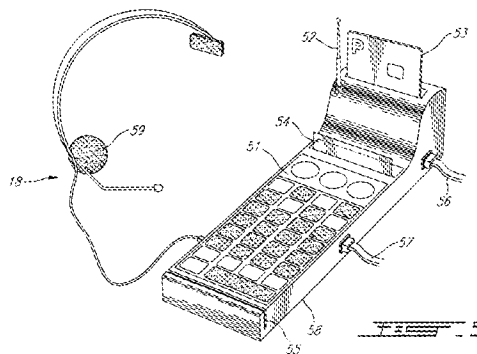


FIG. 5 of Ouimet

In fact, the Ouimet specification teaches away from using any type of contactless technology smart card:

For security purposes, the use interface of terminal 18 will only operate in the preferred embodiment when the parking warden inserts a personal identification smart card into the reader 53 and then enters a personal identification code using the key pad 51. If

⁴ July 27, 2006, Final Office Action, paragraph 8.

⁵ Wikipedia definition at http://en.wikipedia.org/wiki/Smart_card.

the smart card is removed from the reader during normal use of the terminal 18, the terminal is locked out. Ouimet p. 8, ll. 22-28 (emphasis added).

The contactless card standard was codified by ISO in 2001.⁶ This standard allows communication of these new cards at distances of 10 cm to 50 cm (3 to 15 inches). Even today, contactless smart cards are limited to close proximity use, such as garage door openers or building security badges, because antennas cannot generate enough power for long distance wireless transmissions. Applicant directs the Examiner to U.S. Patent No. 6,572,015 issued to Norton for a Smart Card Authorization System, Apparatus and Method, which was filed on July 2, 2001, and is assigned to BellSouth Intellectual Property Corporation. Norton disclosed in 2001 a novel use of a contactless smart card to transmit an authorization code to operate a vehicle or other equipment. If as shown in Norton in 2001 that it was not obvious to use a contactless smart card to open a car door or start a car engine, surely in 2000 it was not obvious to use a contactless smart card as a reference identifier to conduct parking operations. For this reason, this rejection is traversed and allowance of the pending claims is solicited.

III. Conclusion

Based on the above amendments and remarks, Applicant submits that all remaining claims are now in proper condition for allowance, and such action is earnestly solicited. The Commissioner is hereby authorized to charge any underpayment or credit any overpayment to Deposit Account No. 22-0259

⁶ ISO/IEC 14443 standard.

or any payment in connection with this communication, including any fees for extension of time that may be required. The Examiner is also invited to call the undersigned if such action might expedite the prosecution of this application.

Respectfully submitted,

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